REMARKS/ARGUMENTS

The non-final Office Action of December 30, 2005, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 33, 35, 39, and 49 have been amended to further clarify the scope of protection of the claims. Claims 34, 36, and 38 have been canceled without prejudice or disclaimer. Claims 51-52 have been added. Claims 17-18, 33, 35, 37, and 39-52 remain pending in this application. Claims 35, 37, 39-44, 49-50, and 52 are independent claims.

Rejections Under 35 U.S.C. § 112, second paragraph

Claim 34 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter to which the Applicants regard as the invention. Applicants have canceled dependent claim 34 thus rendering the present rejection moot.

Rejections under 35 U.S.C. § 102

Claim 39 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Kreisel (U.S. Patent No. 6,088,516, hereinafter referred to as *Kreisel*). Applicants respectfully traverse this rejection.

Applicants' amended claim 39 recites, among other features, "wherein said determining step includes determining whether an instant message or an email message has been received, wherein said changing step includes changing the state associated with the illumination member in response to determining an instant message has been received." Applicants' amended claim 39 is fully supported by the original written description and drawings. The Action fails to cite any reference that teaches or suggests this feature of Applicants' claim 39.

The *Kreisel* system describes an E-mail system in which authorized users are afforded the ability to create multiple network sites and in which a visual indicator is provided upon the keyboard to identify new messages. (Abstract). The Action relies on reference element 204 in Figure 2 and column 8, lines 61-66 of *Kreisel* as describing determining whether an instant

message has been received. Neither the cited portion of *Kreisel* nor any other portion of *Kreisel* teaches or suggests at least this feature. The cited portion reads,

> FIG. 2 illustrates the processing sequence (hereafter the "LED control function") performed at set intervals when called by the New Mail Interrupt. When called (step 200), the LED control function reads a global or system variable or flag identifying incoming mail (step 202) and evaluates the state of the Flag (true or false) (step 204).

At best, *Kreisel* describes an email system. *Kreisel* fails to teach or suggest anything with respect to instant messaging technology and further fails to teach or suggest any type of difference between receipt of an incoming email and an incoming instant message. Accordingly, claim 39 is allowable over *Kreisel* and withdrawal of the rejection is respectfully requested. Applicants' new dependent claim 51 depends from claim 39 and is at least allowable over the art of record for the same reasons as its ultimate base claim and further in view of the novel features receited therein. New claim 51 is fully supported by Applicants' original written description and drawings.

Rejections under 35 U.S.C. § 103(a)

Claims 33-36, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Stanek (U.S. Patent No. 5,936,554, hereinafter referred to as *Stanek*). Applicants respectfully traverse this rejection.

Applicants' independent claims 35 and 49 have been amended to include many of the features of dependent claim 36. As admitted by the Action, *Kreisel* in view of *Stanek* fails to specifically teach the features of dependent claim 36 (Action, page 3). To cure these deficiencies, the Action alleges,

> On the other hand, Kreisel teaches a communications package 3 [that] includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received messages (Fig. 4(204)).
> It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Kreisel's message storage as illustrated in

computer system of Fig. 1b inside a modified Kreisel device for the purpose of tracking the status of each message received as taught by Kreisel (col. 3, lines 17-27). (Action, page 4).

However, neither this statement nor the cited portion teach or suggest anything with respect to, "establishing a set of senders, wherein said determining step includes determining whether a sender of an incoming message is in the set," as recited in Applicants' claims 35 and 49. The statement in the Action and the cited portions of *Kreisel* at best describe storage and analysis of incoming emails where the state of a Flag, identifying reception of a new email, is evaluated. Neither *Kreisel* nor *Stanek* teach or suggest anything with respect to the sender of an incoming message. Applicants do no disagree that *Kreisel* describes evaluation of state of a Flag identifying reception of a new email; however, this does not amount to the features of Applicants' claims 35 and 49. As such, for at least these reasons, Applicants respectfully request withdrawal of the present rejection of claims 35 and 49. Claims 34 and 36 have been canceled without prejudice or disclaimer.

Claims 37-38, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel*. Applicants respectfully traverse this rejection.

Applicants' claim 37 recites, among other features, "establishing a set of senders, wherein said determining step includes determining whether a sender of an incoming message is in the set." As admitted by the Action, *Kreisel* fails to specifically teach these features. (Action, page 5). In response, the Action provides the same statement and citations of *Kreisel* as described above with reference to Applicants' claims 35 and 49. For similar reasons as described above with reference to Applicants' claims 35 and 49, *Kreisel* describes evaluation of state of a Flag identifying reception of a new email; however, this does not amount to the features of Applicants' claim 37. As such, for at least these reasons, Applicants respectfully request withdrawal of the present rejection of claim 37. Amended claim 33, which depends on claim 37, is patentably distinct over the art of record for at least the same reasons as its ultimate base claim and further in view of the novel features recited therein. Claim 38 has been canceled without prejudice or disclaimer thus rendering the present rejection of claim 38 moot.

Applicants' claim 40 recites, among other features, "wherein said determining step includes determining whether a request to respond to one of a video conference call and an audio conference call has been received." As admitted by the Action, *Kreisel* fails to specifically teach this feature (Action, page 6). In response, the Action alleges,

> Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 60-62).
> It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

However, neither this statement nor the cited portions of *Kreisel* teach or suggest anything with respect to, "wherein said determining step includes determining whether a request to respond to one of a video conference call and an audio conference call has been received," as recited in Applicants' claim 40. The statement in the Action and the cited portions of *Kreisel* at best describe a system where various computers have a common application program running and the communications are email communications. Neither *Kreisel* nor *Stanek* teach or suggest anything with respect to receipt of a request to respond to a video conference call or an audio conference call. Applicants do no disagree that *Kreisel* describes transmission and identification of receipt of a new email; however, this does not amount to the features of Applicants' claim 40. As such, for at least these reasons, Applicants respectfully request withdrawal of the present rejection of claim 40.

Claims 41 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Pennell et al. (U.S. Patent No. 6,874,023, hereinafter referred to as *Pennell*). Applicants respectfully traverse this rejection.

Applicants' independent claim 41 recites, among other features, "wherein said determining step includes determining whether a user is capable of receiving a solicitation." As admitted by the Action, *Kreisel* fails to teach or suggest this feature. (Action, page 7). To cure these deficiencies, the Action relies on Figure 4 and column 1, lines 42-45 of *Pennell* and states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made

to modify Kreisel's email communication shown in Fig. 1b to adapt Pennell's user control with respect to emails as indicated in Figure. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell." (Action, page 7). However, the combination of references fails to teach or suggest Applicants' claim 41 feature of, "wherein said determining step includes determining whether a user is capable of receiving a solicitation." Even under the *Pennell* system, a user is only notified, on a display screen, of new email messages, and there is nothing in *Pennell* to teach or suggest whether a user is capable of receiving a solicitation. As such, for at least these reasons, Applicants respectfully request withdrawal of the present rejection of claim 41.

Even assuming, without admitting, that the combination of *Kreisel* and *Pennell* teaches or suggests each and every feature of Applicants' claim 41, the motivation to combine *Kreisel* and *Pennell* is improper. *Kreisel* is directed to flashing of particular LEDs on a keyboard upon receipt of a new email. *Pennell*, on the other hand, is a web based application in which a user has an account and visual notification on a display screen may be provided regarding a number of criteria, such as a new email message. There is no motivation provided in either of *Kreisel* or *Pennell* to combine the hardware applications of *Kreisel* with the software based Internet communication controls of *Pennell*. As such, there is no motivation shown to combine *Kreisel* with *Pennell*.

Applicants' independent claim 50 recites, among other features, "wherein said determining step includes determining whether a request to respond to a solicitation to join a chat room has been received." As admitted by the Action, *Kreisel* fails to teach or suggest this feature. (Action, page 8). To cure these deficiencies, the Action relies on the same portions of *Pennell* as described above with respect to Applicants' claim 41 and further states that, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communication and interacting with one another." However, the Action appears to contend that mere capability to transmit email messages between computers constitutes the capability to chat within a chat room. The differences in capabilities between the two are numerous and such a contention, if being made, is not supported by the references themselves. As such, for at least these reasons,

Applicants respectfully request withdrawal of the present rejection of claim 50. In addition, for at least the same reasons as provided above with respect to Applicants' claim 41, the motivation to combine *Kreisel* with *Pennell* is improper.

Claims 42 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Macko (U.S. Patent No. 6,052,563, hereinafter referred to as *Macko*). Applicants respectfully traverse this rejection.

Applicants' independent claim 42 recites, among other features, "wherein said determining step includes comparing a scheduled event time relative to an actual time set in the computer." As admitted by the Action, *Kreisel* fails to teach or suggest this feature. (Action, page 9). To cure these deficiencies, the Action relies on *Macko*.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim features. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine *Kreisel* with *Macko*. As reason for combing the references with respect to Applicants' claim 42, the Action states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Macko's email forwarding program (700) as configured in FIG. 13 because an email forwarding program helps automatically forward emails to a communication device (100) as taught by Macko." Office Action, p. 9. However, the alleged reason does not provide motivation to combine the references, but rather is nothing more than the conclusion apparently reached after having benefited from reading Applicants' own disclosure, and thus constitutes impermissible hindsight. The Action alleges that the motivation to combine the references can be found in Figure 13 and column 8, lines 1-4 and 56-67 of *Macko*. This cited portion of *Macko* reads,

> If any other messages are received during this appointment, the communication device will send a response message indicating that he/she is in a meeting...

The electronic mail (email) forwarding application is selected for activation when a travel appointment, or any other particular appointment, is entered. Referring to FIG. 13 in conjunction with FIGS. 1 and 3, the email forwarding application will be described. When active, in step 700 a flag is set to activate a companion program in the PC to forward email for the duration of the scheduled appointment. In step 702, the appointment and associated configuration information in the communication device 100 is synchronized with that of the companion program in the PC 130 (normally at least once a day).

However, the communication device of *Macko* correlates to a cellular telephone (col. 1, lines 6-10) and neither *Macko* nor *Kreisel* teaches or suggests use of features in a cellular telephone in a computer input device. Even assuming without admitting that the combination of *Macko* and *Kreisel* teaches or suggests each and every feature of Applicants' claim 42, the above description of Figure 13 of *Macko* would teach away from such a need. Email would not need to be forwarded to a communication device if we are referring to a computer input device. Changing a state of an illumination member of a computer input device connected to PC 130 of *Macko* would be useless as any emails are merely forwarded to a user's cellular telephone.

The Federal Circuit has repeatedly stated that the elements of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine *Kreisel* with *Macko*.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of one of ordinary skill at the time the claimed invention was made. Nor does the Office Action provide any evidence that the combination includes knowledge gleaned from any source other than Applicants' disclosure. As such, utilizing the teachings of Applicants' written description and drawings, the Action merely cites *Macko* in an attempt to piece the rejection together. Therefore, the combination is an improper combination based on hindsight. For at least these reasons, Applicants respectfully request withdrawal of the present rejection of claim 42.

Applicants' claims 17-18, which depend from claim 42, are patentably distinct over the art of record for at least the same reason as their ultimate base claim and further in view of the novel features recited therein.

Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Suzuki et al. (U.S. Patent No. 5,890,139, hereinafter referred to as *Suzuki*). Applicants respectfully traverse this rejection.

Applicants' independent claim 43 recites, among other features, "wherein said determining step includes determining whether a correct answer has been input." As admitted by the Action, *Kreisel* fails to teach or suggest this feature. (Action, page 10). To cure these deficiencies, the Action relies on *Suzuki*. Specifically, the Action relies on element S109 of Figure 5 and column 7, lines 8-14 of *Suzuki* and states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Suzuki's answer transmission via email (109) as configured in Fig. 5 because the use of answer transmission via email helps function online shopping as taught by Suzuki." (Action, page 11). However, the combination of references fails to teach or suggest Applicants' claim 43 feature of, "wherein said determining step includes determining whether a correct answer has been input." Even under the *Suzuki* system, an answer to a customer's question is always transmitted to the user and neither system, whether *Kreisel* of *Suzuki*, teaches or suggest determining whether the transmitted answer is a correct answer. Suzuki teaches or suggests nothing with respect to determining the accuracy of an answer that the mail order center 100 provides. As such, for at least these reasons, Applicants respectfully request withdrawal of the present rejection of claim 42.

Even assuming, without admitting, that the combination of *Kreisel* and *Suzuki* teaches or suggests each and every feature of Applicants' claim 42, the motivation to combine *Kreisel* and *Suzuki* is improper. *Kreisel* is directed to flashing of particular LEDs on a keyboard upon receipt of a new email. *Suzuki*, on the other hand, is a web based question and answer system in which answers are provided to a customer from minimum necessary answers to questions prepared in a database. There is no motivation provided in either of *Kreisel* or *Suzuki* to combine the two references.

Claims 44-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Gough et al. (U.S. Patent No. 6,360,221, hereinafter referred to as *Gough*). Applicants respectfully traverse this rejection.

Applicants' independent claim 44 recites, among other features, "wherein said determining step includes determining one of a state, a characteristic, and a condition relating to a character in a game program." As admitted by the Action, *Kreisel* fails to teach or suggest this feature. (Action, page 11). To cure these deficiencies, the Action relies on *Gough*.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim features. *See* MPEP § 706.02 (j); *In re Vaeck* , 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine *Kreisel* with *Gough*. As reason for combing the references with respect to Applicants' claim 44, the Action states, ""it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Gough's enhanced interactive email driven game as demonstrated in Fig. 13 because the use of enhanced interactive email helps attract users and members to the websites as taught by Gough." Office Action, pp. 11-12. However, the alleged reason does not provide motivation to combine the references, but rather is nothing more than the conclusion apparently reached after having benefited from reading Applicants' own disclosure, and thus constitutes impermissible hindsight. The Action alleges that the motivation to combine the references can be found in Figure 13 and column 15, line 66 to column 16, line 13 and column 2, lines 45-49 of *Gough*. This cited portion of *Gough* describes how two individuals can email one another back and forth making new moves in a chess game. The cited portion states that the email includes an interactive game of chess, but fails to teach or suggest in any manner as to how the email could possibly interact with a computer input device of a user. There is no motivation in *Gough* or *Kreisel* to change a state

associated with the illumination member on a computer input device in response to determining one of a state, a characteristic, and a condition relating to a character in a game program.

The Federal Circuit has repeatedly stated that the elements of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). That is exactly what is occurring here as the Action specifies nothing for motivation to combine the two references. Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine *Kreisel* with *Gough*.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of one of ordinary skill at the time the claimed invention was made. Nor does the Office Action provide any evidence that the combination includes knowledge gleaned from any source other than Applicants' disclosure. As such, utilizing the teachings of Applicants' written description and drawings, the Action merely cites *Gough* in an attempt to piece the rejection together. Therefore, the combination is an improper combination based on hindsight. For at least these reasons, Applicants respectfully request withdrawal of the present rejection of claim 44.

Applicants' claims 45-48, which depend from claim 44, are patentably distinct over the art of record for at least the same reason as their ultimate base claim and further in view of the novel features recited therein.
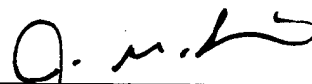
New claim 52 is fully supported by Applicants' original written description and drawings and no new search is required. Neither any art of record alone or in combination with any other art of record, teaches or suggests each and every features of Applicants' claim 52. As such, allowance of new claim 52 is respectfully requested.

CONCLUSION

All objections and rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. If any additional required fees are or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicant looks forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,
BANNER & WITCOFF, LTD.

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